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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,400	01/28/2004	Jun Miyajima	00862.023442	2547

5514 7590 03/27/2007  
FITZPATRICK CELLA HARPER & SCINTO  
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NEW YORK, NY 10112

EXAMINER
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SEVERSON, JEREMY R

ART UNIT	PAPER NUMBER
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3653

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/765,400	MIYAJIMA, JUN	
	Examiner	Art Unit	
	Jeremy R. Severson	3653	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Objections*

Claim 5 is objected to because of the following informalities:

- In claim 5, line 5, "number of index sheets per set paper sheet set"  
should be "number of index sheets per set of paper sheet set" or the like.

Appropriate correction is required.

In several claims, "paper sheet" is not pluralized. The Examiner brings this to Applicant's attention, as it may be a typographical error.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dei (US 4,763,889) in view of Tomidokoro (US 5,722,029).

Re claim 1, Dei discloses an image forming apparatus having a plurality of paper feed units capable of setting index sheets, comprising: a storage section (4-6) which stores size information in a case where index sheets are set in the plurality of paper

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feed units; and a control section (16) which performs processing of automatically changing the paper feed unit to be used from a first paper feed unit to a second paper feed unit and does not perform processing of automatically changing the paper feed unit from the first paper feed unit to a third paper feed unit in a case where index sheets set in the first paper feed unit are run out, wherein the size information of the first paper feed unit coincide with those of the second paper feed unit, and wherein the size information of the first paper feed unit do not coincide with those of the third paper feed unit. See, e.g., Dei, col. 2, lines 17-35.

Dei lacks the explicit disclosure of the storage section storing index number information indicating the number of index sheets per set of paper sheets set in each paper unit. Tomidokoro teaches a storage section storing index number information indicating the number of index sheets per set of paper sheets set in each paper unit, for accurate tab copying. See Tomidokoro, col. 8, lines 46 et seq. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a storage section storing index number information indicating the number of index sheets per set of paper sheets set in each paper unit, to the apparatus of Dei, as taught by Tomidokoro, for accurate tab copying.

Dei teaches the desirability of using operator-set parameters regarding the paper types to govern the automatic change of paper feed units. See Dei, col. 5, lines 17-45. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the number of index sheets set in each paper unit to govern the automatic change of paper feed units in the manner described above.

Re claim 2, the apparatus of Dei as modified by Tomidokoro comprises the apparatus according to claim 1, wherein said storage section stores information indicating a type of the paper sheet set in the paper feed unit (see Dei, col. 5, lines 17-45), wherein the type information of the first paper feed unit coincides with those of the second paper feed unit, and wherein at least one of the size information, the index number information and the type information of the first paper feed unit do not coincide with those of the third paper feed unit.

Re claim 3, the apparatus of Dei as modified by Tomidokoro comprises the apparatus according to claim 1.

Dei does not explicitly disclose said storage section storing index shape information indicating a shape of the index portion of the paper sheet set in the paper feed units, wherein the index shape information of the first paper feed unit coincides with that of the second paper feed unit, and wherein at least one of the size information, the index number information and the index shape information of the first paper feed unit do not coincide with those of the third paper feed unit. Tomidokoro teaches a storage section storing index shape information, for accurate tab copying. See Tomidokoro, col. 8, lines 17 et seq. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a storage section storing index shape information to the apparatus of Dei, as taught by Tomidokoro, for accurate tab copying.

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Dei teaches the desirability of using operator-set parameters regarding the paper types to govern the automatic change of paper feed units. See Dei, col. 5, lines 17-45. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the index shape information set in each paper unit to govern the automatic change of paper feed units in the manner described above.

Re claims 4-8, the apparatus of Dei as modified by Tomidokoro comprises the apparatus according to claim 1, wherein the image forming apparatus further comprises a unit change setting section which determines whether to automatically enable paper feed unit change processing for each of the plurality of paper feed units and sets a unit change setting in accordance with the determination result, and wherein the unit change setting section sets the unit change setting to automatically enable change processing for the second paper feed unit. See Dei, cols. 3 and 4.

### ***Response to Arguments***

Applicant's arguments filed 8 March 2007 have been fully considered but they are not persuasive.

Applicant traverses the rejections from the prior office action. The Examiner respectfully disagrees. The references used in the rejections have been changed in light of Applicant's amendment.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, the Examiner respectfully submits that the teachings of Dei and Tomidokoro references together render Applicant's claims obvious, as explained in the rejections above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Severson whose telephone number is (571) 272-2209. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey, can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeremy R Severson  
Examiner  
Art Unit 3653

jrs

  
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